

REMARKS

In the Office Action, the Examiner objected to claims 1 to 29 under 35 U.S.C. §102 as being anticipated by Baerlocher et al (US 7,094,148 B2). Applicant respectfully disagrees with these rejections for the following reasons:

5 Baerlocher is a continuation-in-part of U.S. Non-Provisional Application No. 10/661,443, filed on September 13, 2003, which is a continuation-in-part of U.S. Non-Provisional Application No. 10/241,255, filed on September 11, 2002.

10 The present application (hereinafter "Application") claims priority to U.S. Provisional Application No. 60/412,012, filed on September 20, 2002. However, a priority claim to a patent filing with a filing date of May 15, 2002, was unintentionally omitted and a petition to include the additional priority date has been filed with the U.S. Patent and Trademark Office.

15 If the earlier priority claim is accepted, the Application will have a priority date back to May 15, 2002, or approximately four (4) months prior to Baerlocher's earliest priority date of September 11, 2002. Thus, the amended priority claim eliminates Baerlocher as prior art under 35 U.S.C. §102(e).

If the earlier priority claim is not accepted, Applicant respectfully submits that Claims 1 to 29 are still patentable over Baerlocher, as the Application teaches novel methods of operating a slot machine game that are distinguishable from the methods described in Baerlocher.

20 The Application, as described in independent claims 1, 19 and 20, teaches a method of playing a game using a symbol matrix formed by plurality of rows intersecting a plurality of columns, with the plurality of rows and columns defining a plurality of symbol positions. The game begins by displaying random symbols in each symbol position of the symbol matrix, issuing awards for any winning symbol combinations displayed in the symbol matrix, and setting

the status of each symbol position to locked or unlocked. The game then continues by randomly generating symbols for each unlocked symbol position, displaying the symbols generated for the unlocked symbol positions, and issuing awards for any winning symbol combinations displayed in the symbol matrix. The game ends once the status of all symbol positions are set to locked.

5 More specifically, Claim 1 teaches a slot-type game that continues "...if any symbol positions are unlocked, repeating the following steps until all positions are locked: 1) randomly generating symbols for each unlocked symbol position; 2) displaying the symbols generated for each unlocked symbol position; and 3) issuing awards for winning symbol combinations displayed in the symbol matrix." (Application at page 34, line 19 to page 35, line 3.)

10 Similarly, independent Claim 19 states in relevant part that "when at least one symbol position is unlocked, repeating, until all symbol positions are locked, the following at one of sequential, non-sequential and sequence independent steps of: 1) randomly generating symbols for each unlocked symbol position; 2) displaying the symbols generated for each unlocked symbol position which replaces a previously displayed symbol; and 3) issuing at least one award
15 for winning symbol combinations displayed in the symbol matrix." (Application at page 45, lines 11-22.)

Again, independent Claim 20 describes in relevant part "means for setting the status of each symbol position as either 'locked' or 'unlocked' responsive to a predetermined criteria, and when at least one symbol position is unlocked, means for repeating, until all symbol positions are
20 locked, the functions of: 1) randomly generating symbols for each unlocked symbol position; 2) displaying the symbols generated for each unlocked symbol position which replaces a previously displayed symbol; and 3) issuing at least one award for winning symbol combinations displayed in the symbol matrix." (Application at page 46, line 13 to page 47, line 2.)

Thus, the Application teaches methods by which every game provides the player with an initial opportunity to form winning symbol combinations and then continues to provide additional opportunities to form winning symbol combinations using symbols appearing in locked and unlocked symbols positions until all symbol positions are locked.

5 Baerlocher discloses a gaming device including a slot machine game with a two (2) stage free spin mode using locking and terminating symbols. During the primary game, a trigger event initiates a first stage free spin mode that provides unlimited free spins until a locking symbol and a terminating symbol appear. A second stage free spin mode then provides a finite number of free spins with at least one locking symbol held stationary on the slot reels for each free spin.

10 Awards are provided to the player for winning symbol combinations occurring in each free spin.

More specifically, Claim 1 of Baerlocher states that the gaming device comprises:

15 a primary game controlled by the processor and operable upon a wager by the player; and free spin mode controlled by the processor and this is initiated if a trigger event occurs in a play of the primary game, wherein said free spin mode includes: (a) an unlimited number of free spins of a plurality of reels without an additional wager by the player, said reels including a plurality of symbols, said plurality of symbols including at least one locking symbol and at least one terminating symbol ... and (b) a free spin mode terminating event triggered upon the generation of at least one of the locking symbols and at least one of the

20 terminating symbols in one of said free spins, wherein in the free spin mode terminating event a finite number of additional free spins of the reels are provided, said finite number being at least one, and for each said additional free spin, at least one locking symbol on the reels is held stationary. (Baerlocher, column 24, lines 14 to 35.)

25 Baerlocher does not disclose a game that continues to operate until all symbol positions are locked. In Baerlocher, locking symbols do not terminate either stage of the free spin mode. The first stage of the free spin mode terminates upon the appearance of as few as one terminating symbol and one locking symbol. The second stage of the free spin mode terminates after a finite

30 number of free spins without regard to the appearance of locking symbols. Thus, locking

symbols or locked symbol positions do not control the duration of the game.

Even assuming, arguendo, that Baerlocher did use locking symbols to terminate a game, Baerlocher's disclosure of a two (2) stage free spin round using locking and terminating symbols does not appear in the referenced patent application relied upon for the September 11, 2002
5 priority date (U.S. Non-Provisional Application No. 241,255, now U.S. Patent No. 7,056,213; hereinafter "Ching").

Ching discloses a gaming device including a slot machine game with a one (1) stage award mode. During the primary game, the appearance of a trigger symbol on a payline initiates the award mode during which the reels without the trigger symbol display wild symbols on that
10 payline and the reel with the trigger symbol spins and re-spins until an award symbol is displayed on that payline to form a winning combination and generate an award for the player.

More specifically, Ching states that the game operates by:

...initiat[ing] an award mode when the trigger symbol is indicated on the payline, indicate wild symbol on the payline on all of the reels except the reel including
15 the trigger symbol in the award mode, re-activate the reel including the trigger symbol until an award symbol is indicated on the payline in the award mode, and provide a player the award, if any, associated with one of the combinations of said indicated award symbol. (Ching, column 13 line 62 to column 14, line 3.)

The award mode terminates upon the formation of a winning symbol combination or
20 upon the completion of all spins in the award mode, as disclosed in Ching:

The gaming device then provides the award associated with the indicated award symbol combination to the player. The award is added to the player's total award in a total award display and the bonus mode ends. In another embodiment, the
25 player continues to reactivate the reels in the award mode if the player has spins remaining in the award mode. (Ching, column 3, lines 27 to 36.)

Ching does not disclose more than one (1) stage of an award mode and, therefore, cannot disclose the use of a locking symbols and a terminating symbol to transition between multiple stages of an award mode, as disclosed by Baerlocher, columns 19 to 23, and illustrated in

Baerlocher, figures 8 to 10B.

Moreover, Ching does not disclose reels with at least one locking symbols and one terminating symbol and, therefore, cannot disclose the random appearance of locking symbol on the reels to lock any one of the symbol positions on that reel, as disclosed by Baerlocher, as disclosed by Baerlocher, columns 19 to 23, and illustrated in Baerlocher, figures 8 to 10B.

In view of the foregoing remarks, Applicants respectfully submit that Baerlocher is not prior art, and regardless, Baerlocher does not teach, disclose or suggest the methods described in the Application, and furthermore, the methods cited by the Examiner in Baerlocher are new subject matter which are unsupported by the Ching parent application

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable.

Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

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For all the reasons advanced above, Applicant respectfully submits that the Application is in condition for allowance, and that such action is earnestly solicited. If there is any matter that would delay this Application from passing to issue, the Examiner is requested, at the earliest convenience, to telephone the undersigned.

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Respectfully submitted,


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